

**SECTION ONE:
GOETZ '190 IS NOT PRIOR ART**

In accord with the examiner's suggestions, the Applicant has submitted an amended Rule 131 affidavit to show precisely what elements of the invention were reduced to practice before December of 1997. The new affidavit is annexed hereto as Exhibit 1.

Note that these elements comprise the majority of the claimed subject matter, and certainly establish possession of this material prior to Goetz having possession of any element set forth in the affidavit. Therefore, applicant clearly avers to possession of the claimed invention before December of 1997.

Attention is invited to the letter from Kemnitzer Design, Inc., dated December 1997. This paper clearly establishes that the Applicant had at least eleven of the claimed limitations in his possession at least as early as December 17, 1997. Even though Applicant had already reduced to practice his entire invention, and therefore ALL of the claimed limitations were in his possession prior to December 1997, this Kemnitzer letter establishes *eleven distinct limitations* of applicant's claimed invention *in a writing that predates Goetz*. The remaining elements that were not mentioned by the drafter of the Kemnitzer letter were evidently overlooked by the drafter of the Kemnitzer letter, even though these already-existing elements form important parts of the inventive combination.

The affidavit also incorporates a Medx System Flow Chart that was created prior to December of 1997. Even though the Applicant had already reduced to practice his entire invention, and therefore all of the claimed limitations were in his possession before December of 1997, the flowchart clearly establishes that *at least ten of the claimed limitations* were in Applicant's possession prior to December of 1997.

The addition of these statements clearly establishes that the Applicant reduced his invention, as set forth in Claims 1-19, before the earliest effective filing date of the Goetz reference. As such, Goetz is not prior art.

An affidavit swearing behind a reference must contain an averment that the subject

matter of the claims was invented prior to the effective date of the reference, and should be accompanied by documents establishing such. See, 37 CFR 131. The accompanying documents and exhibits need not support all claimed limitations; instead, any limitations missing from the document should be supported by the declaration itself. See, e.g., MPEP 715.07 at p. 700-210, Col 1, citing *Ex Parte Ovshinsky* 10 USPQ2d 1075 (Bd. Pat. App. 1989).

Application of the above admonitions to the instant case is straightforward. However, in the final sentence of paragraph 8 of the Office Action, the examiner pointed out that the submitted documentary materials are not tied to each and every claimed element. In contrast, *each and every claimed element need NOT BE SET FORTH in the documentary material*, as there is NO requirement that the documentary evidence submitted along with the affidavit corroborate the averments set forth in the affidavit. See, *Ex Parte Swaney and Banes*, 89 USPQ 618 (Bd. Pat. App. 1950). Additionally, the documents need not bear dates the actual date that the document was created. Instead, the applicant may allege in the body of his affidavit that the document was created before a specified time. See, M.P.E.P. 715.07.

In the instant case, the flow chart attached as Exhibit A did not bear a date. However, Applicant has averred under oath, in paragraph 6 of the attached Affidavit, that the document was created no later than December of 1997. Consequently, this document is sufficient and should be considered, and further provides documented evidence that Applicant possessed the claimed invention prior to December of 1997, thereby eliminating Goetz from the body of prior art that may be used to reject Applicant's claims.

The affidavit submitted by Applicant specifically avers that he completed the inventive process prior to December 1997. The affidavit contains detailed explanation that shows how each document attached thereto is relevant to the inventive process. True, some of the documents do not set forth elements of the invention; however, this is not required under the proper standard set forth in *Ovshinsky* and in MPEP 715.07.

The attached affidavit incorporates the suggestions of the examiner by more particularly setting forth the material that came into the possession of the applicant, and precisely sets forth exactly what elements of invention were reduced to practice prior to the earliest effective filing date of the Goetz reference. As such, Goetz has been clearly eliminated from the body of prior art.

Because Goetz forms the sole basis for the rejections set forth in the Office Action, and the Rule 131 Affidavit clearly obviates the Goetz disclosure, the application should be allowed over Goetz.

SECTION TWO

THE DISCLOSURE OF THE PROVISIONAL APPLICATION 60/093,753 FAILS TO ESTABLISH PRIORITY FOR THE ELEMENTS RELIED UPON BY THE EXAMINER TO REJECT THE APPLICANT'S CLAIMS, AND THEREFORE APPLICANT CAN CLEARLY ESTABLISH POSSESSION OF THE CLAIMED SUBJECT MATTER BEFORE GOETZ '190.

The Goetz '190 reference is a continuation-in-part application of Application Number 09/261,044, which was filed on March 2, 1999. Application number 09/261,044 was a continuation-in-part application of Application number 09/260,936, which was filed on March 2, 1999. Neither Application 09/260,936 nor Application 09/261,044 was allowed. Additionally, each of these applications ('044 and '936), which were never allowed, referred to Provisional Application 60/093,753, which was filed on July 22, 1998.

The M.P.E.P in pertinent part, provides as follows:

**PARENT'S FILING DATE WHEN REFERENCE IS A
CONTINUATION-IN-PART OF THE PARENT**

Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527 (CCPA 1981).

[In] *Ex parte Gilderdale*, the examiner made a 35 U.S.C. 102(e) rejection over a U.S. patent to Hernandez. See, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal no. 89-0352). Hernandez was a continuation of a continuation-in-part. Both the parent and grandparent had been abandoned. The parent listed a different inventive entity but supported the subject matter of the child's claims. The parent was filed on the same day as the examined application and thus no 35 U.S.C. 102(e) rejection could be made based on the parent's filing date. The Board reversed the rejection, explaining that the Hernandez patent was entitled to the filing date of its parent, as the parent supported the patent claims and 35 U.S.C. 120 was satisfied. Under 35 U.S.C. 120, an application can claim the benefit of an earlier filing date even if not all inventors are the same. However, Hernandez was not entitled to the grandparent filing date because the parent and child applications contained new matter as compared to the grandparent.

Compare *Ex parte Ebata*, 19 USPQ2d 1952 (Bd. Pat. App. & Inter. 1991) The claims were directed to a method of administering a salt of lysocellin to animals. A 35 U.S.C. 102(e) rejection was made over Martin. Martin was a continuation of an application which was in turn a continuation-in-part of an abandoned application. The grandparent application disclosed administering a manganese complex of lysocellin to animals. The Board found that "the new matter relates to additional forms of lysocellin which are useful in Martin's process, i.e., species or embodiments other than the manganese complex. This is far different from adding limitations which are required or necessary for patentability." Unlike the situation in *In re Wertheim*, Martin's invention was patentable as presented in the grandparent application.).

See, M.P.E.P 2136.03

Clearly, the above and foregoing referenced authorities set forth well-settled principles of law regarding the effective filing date of references. In order for a reference to obtain priority for material set forth in an earlier-filed application, the alleged priority document(s) must sufficiently disclose (under 35 USC 112) the material relied upon. Thus, matter contained in a continuation in part application that differs from – or adds to – the original, parent application will NOT be entitled to the effective date of the parent.

Applying this simple rule to the instant case, it is unquestionable that the Goetz reference cannot rely upon the provisional application as a priority document for much of the disclosure set forth in Goetz ‘190.

Specifically, on p. 5 of the Office action sets forth as follows:

As per claim 3, Goetz discloses a method for managing prescribed medications including:

(a) operating a scheduling and alarm function for prescribed treatments or medications within an electronic component to generate internal values of date and time. (See, Figure 7, col 8, lines 23-53; Col 13, lines 40-67; col 14, lines 1-62; col 15, lines 24-46; col 19, lines 5-22.)

(b) providing an electronic component with an input button interfaced to an alarm (see Fig. 7, col 8 lines 23-53, col 13, lines 40-67, col 14, lines 1-62, col 15, lines 24-46, Col 19, lines 5-22)

(c) pressing an input button to accept or acknowledge administering a prescription (Fig. 7, col 8 lines 23-53, col 13, lines 40-67, col 14, lines 1-62, col 15, lines 24-46, Col 19, lines 5-22)

For the convenience of the examiner, a copy of the Provisional Application 60/093,753, as filed, is annexed hereto as Exhibit 2. A review of this document shows that each of these citations (a), (b), and (c) lacks priority in the Provisional Application 60/093,753. Further, note that Figure 7 does not exist in the Provisional Application. Also, the discourse appearing at Col 8, lines 23-53 of the Goetz ‘190 patent is noticeably absent from the originally-filed, provisional application. Column 13, lines 40-67 contain a detailed explanation of Figure 7 of Goetz ‘190 patent – as stated earlier, Figure 7 does not exist in the Provisional Application. Clearly, the

cited discourse (at Col 13) lacks proper disclosure within the Provisional, and is not entitled to priority in the provisional application. The cited sections on Column 15 refer to Goetz figures 30-35. These figures are absent from the Provisional Application.

The Applicant notes that the apparatus claims 14-19 set forth limitations that cannot find priority in the Provisional Application 60/093,753. Reconsideration of each of these rejections is specifically requested.

SECTION THREE

THE CLAIMED INVENTION IS PATENTABLY DISTINCT FROM THE CITED ART

Claim 1 is drawn to a method including the steps of providing a digital prescription carrier including a read/write memory and a communication interface; uploading prescription data defining a prescription into said carrier through said interface, said prescription calling for the use of a selected medication of a selected dosage on a selected schedule; transferring said carrier by a patient to a pharmacy; downloading said prescription data from said carrier through said interface at said pharmacy. In contrast, Goetz shows that data is contained within a card that can be inserted into *any one of the handler's carrier 12, the veterinarian's carrier 16, or the veterinarian's computer 18*. Because Goetz discloses an invention having several distinct carriers, it teaches away and cannot suggest the claimed combination set forth in Claim 1.

Consequently, claim 1 is allowable over Goetz. Claims 2-6 and 20, which further limit Claim 1, should also be allowed for their separate, patentable limitations.

Claim 7 is drawn to a method including, inter alia, the step of entering a second access code into said carrier to enable software access thereto. As pointed out by the examiner, Goetz mentions a PIN number, which is alleged to read upon *a first access code*. However, Goetz does not disclose, teach, or suggest the step of entering a second access code into said carrier to enable software access thereto. As such, Goetz fails to disclose, teach, or suggest all of the claimed limitations set forth in Claim 7.

Additionally, note that Claim 7 includes references only one carrier. In contrast, Goetz teaches a system having at least two distinct carriers 12, 16. Because Goetz teaches distinct carriers, it cannot teach, suggest or disclose a method including the step of uploading prescription data defining a prescription into a carrier through an interface, and further including the step of downloading the prescription data from the carrier through the said interface. Instead, Goetz teaches the uploading of data while using a first carrier, and the downloading of data using a second carrier. Consequently, Goetz does not teach, suggest or disclose each and every limitation set forth in the claims.

As pointed out above, Claim 7 is allowable over Goetz. Claims 8-13, which further limit claim 7, are likewise allowable for their separate patentable limitations.

Claim 14 is drawn to a combination of elements including the following:

- (a) a carrier housing;
- (b) a central processing unit (CPU) positioned within said housing;
- (c) a display device positioned on said housing, interfaced to said CPU, and capable of displaying alphanumeric characters;
- (d) input/output (I/O) interface circuitry positioned in said housing and interfaced to said CPU, said I/O circuitry being capable of interfacing said CPU to an external computer to exchange data therewith;
- (e) data memory circuitry positioned within said housing
- (f) prescription software stored in said memory to be processed by said CPU,

wherein,

the CPU and the I/O circuitry cooperate to enable

uploading, by a prescriber, of prescription data representing
a prescription into said memory circuitry, and
downloading of said prescription data at a pharmacy.

In contrast, Goetz teaches several distinct carrier housings, and a central processing unit configured to be selectively positioned within any one of the housings. Therefore, Goetz does not show a system where information is entered into a CPU that is positioned within a housing, I/O interface circuitry in the said housing, data memory circuitry positioned with the said housing. Instead, there are several distinct housings Goetz, making Goetz incapable of meeting the claimed limitations set forth in Claim 14.

As pointed out above, Goetz is allowable over the cited art. Claims 15-19, which further limit claim 14, are also allowable for their separate, patentable limitations.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the examiner issue a Notice of Allowance of all pending claims.

Respectfully Submitted,
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CERTIFICATE OF EXPRESS MAIL DELIVERY UNDER 37 C.F.R. 1.10

I HEREBY CERTIFY that the above and foregoing Amendment, together with attachments, exhibits, affidavits, and annexes, was sent via telefacsimile to United States Patent & Trademark Office, Box RCE, Washington DC 20231 on January 14, 2003

A handwritten signature in black ink, reading "David E. Herron II". The signature is written in a cursive style with a horizontal line underneath the name.

David E. Herron II